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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,809	09/22/2003	Thomas F. Adams		1438

7590 10/06/2005  
Werner H. Schroeder  
5550 Heron Point Dr. # 1105  
Naples, FL 34108

EXAMINER

MAHAFKEY, KELLY JO

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/667,809

Applicant(s)

ADAMS, THOMAS F.

Examiner

Kelly Mahafkey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/22/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Definition of a Substitute***

1. Applicant refers to this application as a "substitute" of Application No. [09/493550], filed [1/29/00]. The use of the term "substitute" to designate an application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later case finds official recognition in the decision, *Ex parte Komenak*, 1940 C.D. 1, 512 O.G. 739 (Comm'r Pat. 1940). The notation on the file wrapper (See MPEP §202.02) that one case is a "substitute" for another is printed in the heading of the patent copies. A "substitute" does not obtain the benefit of the filing date of the prior application.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-11, drawn to an ice product made, classified in class 426, subclass 66.
  - II. Claim 12-21, drawn to an apparatus for molding, classified in class 249, subclass 52.
  - III. Claim 22, drawn to a method of making ice, classified in class 426, subclass 66.
3. The inventions are distinct, each from the other because:

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4. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as with a block of ice and an ice pick.

5. Inventions I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus, such as an ice pick.

6. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different processes, such as the molding of a non-edible object like clay.

7. Because these inventions (I, II, and III) are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Werner Schroeder on September 27, 2005 a provisional election was made without traverse to prosecute the invention of the tray, claims 12-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-11 & 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1, 102; Figure 2, 108; Figures 9 & 11, 206; Figure 14, 212''' & 202a'''; Figure 19, L'. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

10. The drawings are objected to because:

- a. Page 9, line 5 "stay-on tab beverage can" is referred to as 10, there is no 10 in the Drawing Figures 1-3. It is suggested that applicant intended to refer to the can as 108.
- b. Page 10, line 1 "ice stick" is referred to as 100", there is no 100" in the Drawing Figure 8A. It is suggested that applicant intended to refer to the ice stick as 100'.
- c. Page 10, line 5 the sidewall is referred to as 110, there is no 110 in Drawing Figures 4-8. It is suggested that applicant intended to refer to the sidewall as 116.
- d. Page 11, line 3 the overflow channels are referred to as 208, which is later referred to as the tray table. It is suggested that applicant intended to refer to the overflow channels as 206. Referring to Drawing Figures 9-11.
- e. Page 11, line 25 the sidewall is referred to as 116, there is no 116 in Drawing Figures 9-11. It is suggested that applicant intended to refer to the sidewall as 202a.
- f. Page 11, line 26 the pattern of sets are referred to as 204a, 204b, 204c,

there is no 204a, 204b, or 204c in Drawing Figures 12 or 13. It is suggested that applicant intended to refer to the sidewall as 204a', 204b', and 204c'.

- g. Page 12, on lines 13-14 "and the chute rim 216 may be raised about one or more inches above the tray table 208 and the chute rim 216 may be raised about one or more inches above the tray table 208" is recited. It is suggested that applicant intended to recite, "and the chute rim 216 may be raised about one or more inches above the tray table 208". Referring to Drawing Figures 12 & 13.
- h. Page 12, line 25 the "alternative tray" is referred to as 200', there is no 200' in Drawing figures 14 or 15. It is suggested that applicant intended to recite alternative tray, referring to 200".
- i. Page 13, line 22 a "tray table" is referred to as 208"', there is no 208"' in Drawing Figures 16 or 17. It is suggested that applicant intended to refer to the table as 208".
- j. Page 14, line 9 recites "the left rim portions 210a, 210b". It is suggested that the applicant intended to recite "the left and right rim portions 210a, 210b". Referring to Drawing Figure 17.
- k. Page 14, line 15 recites "the lateral 200''''", there is no "lateral" in Figure 17. It is suggested that applicant intended to recite "the lateral trays 200''''".
- l. Page 15, line 13 the bottom of the ice, 306 is referred to as "lower", when it

was previously referred to as "bottom". It is suggested that applicant intended to refer to 306 as "bottom". Referring to Drawing Figures 18-22.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

11. The disclosure is objected to because of the following informalities with language:

- a. Page 10, on lines 13-14 "of the sidewall of the sidewall" is recited. It is



suggested that applicant intended to recite, "of the sidewall".

- b. Page 12, on lines 7-9 "an orientation parallel with the lateral compartments 210 at an orientation parallel with the lateral compartments 202" is recited. It is suggested that applicant intended to recite "an orientation parallel with the lateral compartments 202".
  - c. Page 13, on lines 16-17 "inclined rim portions 210a, 210b and a raised rear rim portions 210a, 210b and a raised rim portion 210c" is recited. It is suggested that applicant intended to recite, "inclined rim portions 210a, 210b and a raised rim portion 210c".
12. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 12-15, 19, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Zonca (US 6637721 B1).
15. Zonca teaches of a tray with lateral compartments for creating narrow pieces of small girthed ice articles for openings on portable beverage containers, with one or

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more overflow channels in the tray table to provide a path for self-leveling water (Abstract). In Figure 1 Zonca teaches that the lateral compartments are downwardly formed. Zonca discloses in Column 1 lines 45-49, that the tray compartments have a diameter or girth of less than 0.75 inches, two transverse dimensions, or the width and depth, of less than 0.75 inches. Zonca discloses of a top surface with an elevated rim, rising upwardly from the tray table (Column 2, lines 30-38 and Figure 1 & 5), and a cavity or lateral compartment length of 1-8 inches (Column 2, line 55). On Column 3, lines 1-5 and in Figures 6 (22) and 9 (24) Zonca teaches of a tray with rounded corners, or tapered ends which are in a semi-circle or cylindrical shape, to allow for easy removal.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.  
Ascertaining the differences between the prior art and the claims at issue.  
Resolving the level of ordinary skill in the pertinent art.  
Considering objective evidence present in the application indicating obviousness or nonobviousness.

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18. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zonca as applied to claims 12-15, 19, and 20 above, and in view of Copeman (US 2113014).

19. The difference between the reference and the claim is that the reference is silent to a chute providing a channel for receiving small girthed ice articles formed in lateral compartments and to a portal for the ice articles to exit the tray.

20. Copeman discloses of an apparatus for handling ice cubes in which includes a tray, chute, and portal design for forming and removing the ice cubes into a storage area. Refer specifically to Column 2 lines 35-36 and Column 3 lines 44-46.

21. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of creating a tray as taught by Zonca, to include the a chute and portal for the removal of the ice cubes as taught by Copeman. One would have been motivated to do so in order to take advantage of the benefits of a chute and portal, such as ease of removal of a product from the tray. Because both items deal with the trays that can be utilized to create ice, one would have a reasonable expectation of success from the combination.

22. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zonca as applied to claims 12-15, 19, and 20 above, and further in view of Asenbauer (US 3327896).

23. Although the reference teaches of stacking and a raised rim, the reference is silent to a rim that is raised to a second height.

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24. Asenbauer discloses of a tray with a rim portion that has a first raised height and a second raised height in the in the rear portion, which extends higher than the first raised height. Asenbauer teaches that the tray comprises a perimeter base, which is connected to the rim and projects downwardly so that plurality of trays are stackable. Refer specifically to Figures 1-3 and Column 1, paragraph 1.

25. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of creating a tray as taught by Zonca, to included a raised rim with a second raised rim in the rear as taught by Asenbauer. One would have been motivated to do so in order to take advantage of the benefits of a raised rim with a second raised rim in the rear, such as the ability to stack. Because both items deal with the trays and the process of stacking them, one would have a reasonable expectation of success from the combination.

26. Claims 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zonca as applied to claims 12-15, 19, and 20 above, and further in view of Fan (US D482374 S).

27. The reference teaches of a tray table with an elliptically shaped wall, rounded corners, with a length of 1-8 inches, a girth of less then one inch, and the importance of rounded, or convexly contoured compartments. The reference, however, is silent to the compartments as aligned vertically with an increasing girth.

28. Fan discloses of an ice tray with compartments that are aligned vertically and have an increasing girth. Refer specifically to Claim and Figures 1-5.

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29. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of creating a tray as taught by Zonca, to include the compartments as vertical with an increasing girth as taught by Fan. One would have been motivated to do so in order to take advantage of the benefits of increasing girth, such as the ease of product removal, and the benefits of vertical compartments, such as ability to stacking trays in tall spaces with limited depth and width. Because both items deal with the trays that can be utilized to create ice, one would have a reasonable expectation of success from the combination.

### ***Conclusion***

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

31. US 4156516 discloses of an apparatus for shaping moldable material.

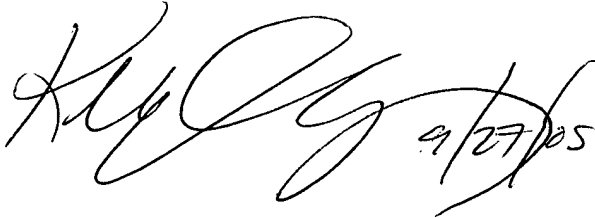
32. US 6761347 B2 discloses of shaped article, or tray with circular and vertical components.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Mahafkey whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kelly Mahafkey', with a date '9/27/05' written to the right of the signature.

Kelly Mahafkey  
Examiner  
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A handwritten signature in black ink, appearing to read 'Wilton L. Casso'.

WILTON L. CASSO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700